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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,825	08/16/2001	Barbara A. Blair	10010714 - 1	3281

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EXAMINER	
THAI, CANG G	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/931,825	BLAIR ET AL.	
	Examiner	Art Unit	
	Cang G. Thai	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 August 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

In the present case, Claim 1 is directed to "a method for developing marketable products incorporating novel technological concepts comprising:

identifying a specific technological concept to develop into a product;

selecting an initial application for the specific technological concept by identifying an entry vehicle application;

proving the technological concept for the entry vehicle application;

identifying additional applications for the proven technological concept; and

developing products based on the entry vehicle and additional applications".

In the present case, Claim 1 does not require any technology. The recited steps of developing marketable products with incorporating novel technological concepts does not apply, involve, use, or advance the technological arts since all of the recited steps can be done with no technology at all. The recited steps only constitute an idea for developing marketable products with incorporating novel technological concepts.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful (specific utility), concrete (repeatability and/or implementation without undue experimentation), and tangible (a real or actual affect) result.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 3-6 are rejected under 35 U.S.C. 101 due the applicant claiming human. A research group, a product development group and a commercialization group are defined as human. See MPEP Section 2105 – Patentable Subject Matter – Living Subject Matter.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is not clear what is the scope of the claimed invention and how the steps are implemented to achieve the scope of the claimed invention? Is it enhancing business development approach or maximizing the company market evaluation or launching a business. Applicant is recommended to insert an objective of the claimed invention in the preamble to improve clarity. Developing marketable products incorporating novel technological concepts is not a proper scope of the claimed invention. It is not clear on the novel technological concepts in the body of the claim and how it is related to the developing marketable products as mentioned in the preamble. It is also not clear on steps (a) – (e). It appears that they should be related, but no positive language showing the relationship has been shown.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,892,376 (MCDONALD ET AL).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As for claim 1, MCDONALD discloses a method for developing marketable products incorporating novel technological concepts comprising:

identifying a specific technological concept to develop into a product {See Fig. 2, Element 20 and Column 1, Lines 41-43, wherein this reads over "current business processes while remaining flexible enough to integrated new processes dynamically as the business changes"};

selecting an initial application for the specific technological concept by identifying an entry vehicle application {See Fig. 2, Element 22 and Column 1, Lines 46-47, wherein this reads over "the steps of defining a workflow type"};

proving the technological concept for the entry vehicle application {Column 1, Lines 47-48, wherein this reads over "building a workflow pointer that defines the location of a database within a network"};

identifying additional applications for the proven technological concept {Column 1, Lines 48-49, wherein this reads over "coding sub-forms for the define workflow type"}; and

developing products based on the entry vehicle and additional applications {Column 1, Lines 61-64, wherein this reads over "this model, both customers and providers of services can focus on any selected process box and come to agreement on the inputs and outputs of that step"}.

As for claim 2, MCDONALD discloses the method of claim 1 wherein the entry vehicle application is narrow enough in scope to reduce development time by concentrating focus on a narrow solution set, but broad and flexible enough to be applicable to additional applications {Column 2, Lines 6-9, wherein this reads over "these business processes also need to help owners define their processes, create new ones and integrated others, and to improve the efficiency and effectiveness of end users through control, communication and collaboration"}.

As for claim 3, MCDONALD discloses a system for enabling a business to develop products comprising:

a research group adapted to conduct research to develop technologies and improve developed technologies {See Fig. 2, Element 12};

a product development group adapted to develop a product based on the use of, or integration of new or improved technologies {See Fig. 2, Element 14};

a technological goal to be achieved by the research group {See Fig. 2, Element 16};

an entry vehicle product architecture goal to be achieved by the product development group {See Fig. 2, Element 20}; and

a commercialization group adapted to tailor and customize the entry vehicle, market the entry vehicle product and its derivatives {See Fig. 2, Element 22};

a joint decision process involving the research, product development and commercialization groups adapted to narrow the scope of research engaged in by the research group and product development group to achieve the technological goal and entry vehicle product development goal, the decision process including identifying an entry vehicle application for the technological goal {See Fig. 2, Element 24}.

As for claim 4, MCDONALD discloses the system of claim 3 wherein the entry vehicle application is narrow enough in scope to reduce development time but broad enough to enable additional applications {See Fig. 3, Element 36}.

As for claim 5, which has the same limitation as in claim 3, therefore, it is rejected for the similar reasons set forth in claim 3.

As for claim 6, which has the same limitation as in claim 4, therefore, it is rejected for the similar reasons set forth in claim 4.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I. U.S. Patent:

1) U.S. Patent No. 6,662,355 (CASWELL ET AL) is cited to teach a method and system for specifying and implementing automation of business process,

2) U.S. Patent No. 6,028,997 (LEYMANN ET AL) is cited to teach a method of generating an implementation of reusable parts from containers of a workflow process-model, and

3) U.S. Patent No. 6,452,613 (LEFEBVRE ET AL) is cited to teach a system and method for an automated scoring tool for assessing new technologies.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang (James) G. Thai whose telephone number is (571) 272-6499. The examiner can normally be reached on 6:30 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT
08/24/2005

S.P.E. 3629